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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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05/11/94 11/17/97 BENJAMIN L.

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EXAMINER

REILLY, M

ART UNIT

PAPER NUMBER

1714

DATE MAILED:

03/17/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09991254

Applicant(s)

BERLOWITZ et al

Examiner

MEDLEY

Group Art Unit

1714

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

☒ Responsive to communication(s) filed on 5/23/00, 8/1/00

☐ This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

☒ Claim(s) 1-2, 4-5, 8, 10, 12-30 is/are pending in the application.

Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-2, 4-5, 8, 10 and 12-30 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All ☐ Some\* ☐ None ☐ of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number)

received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

## Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948

Other \_\_\_\_\_

Office Action Summary

Art Unit: 1714

### DETAILED ACTION

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15-19 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The description is defective because it does not provide description for claim 15(b) "petroleum derived hydrocarbon fraction, wherein the F-T fraction comprises at least 10% of the blended fuel", nor for claim 18 "said petroleum derived hydrocarbon boils in the range of about 250-700°F", nor for claim 19 "said petroleum derived hydrocarbon is selected from the group of raw thermally cracked distillates, hydrogenated catalytically cracked distillates and gas oils". The description found on page 7, paragraph three of the instant application provides a description as follows:

"The product of this invention can be used as a diesel fuel, per se, or blended with other less desirable petroleum or hydrocarbon containing feeds of about the same boiling range. When used as a blend, the product of this invention can be used in relatively minor

cracked distillates and gas oils".

Art Unit: 1714

The above description is the only description found in the originally filed disclosure and claims of the instant application by the Examiner. The specific claimed description found in claims 15(b), 18 and 19 are considered to be new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10, 17 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is indefinite in that it depends from canceled claim 6. Claim 17 directed to a blend improperly depends from process claim 14. In the interest of compact prosecution claims 10 and 17 will be treated on the merits as depending from claims 5 and 16, respectively. However, applicants are required to clarify the record as to the proper claim dependency of claims 10 and 17. Claim 22 depends indirectly from claim 1 and is indefinite in that its lower range of "about 0.001" is outside of claim 1 lower range of "about 0.025".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

Art Unit: 1714

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-5, 8, 10 and 20-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al 5,378,348.

Davis et al teach and disclose processes for producing distillate fraction and blended fuel comprising a 320<sup>0</sup>/500<sup>0</sup>F or 500<sup>0</sup>/700<sup>0</sup> F fraction and an hydroisomerized heavier fraction thereby producing a 320<sup>0</sup>/700<sup>0</sup> F fraction useful as diesel fuel or jet fuel or as blending components, note columns 1, line 41 to column 2, lines 1-66, column 3, line 34 to column 4, lines 1-36, Tables 3-8, Examples 3-8 and claims 1-11. Davis et al teach processes for producing, distillate fraction, and blended fuel having a 320<sup>0</sup>-700<sup>0</sup>F boiling range render obvious applicants process for producing a blended fuel, distillate fraction, and blended fuel comprising a 250/700<sup>0</sup>F boiling range because patentees fraction or blended fuel boiling ranges overlaps the boiling ranges of applicants fractions or blended fuel

...is limited in public policy (a policy reflected in the statutes) ... to prevent the unjustified ... improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

Art Unit: 1714

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4 and 15-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 08/562,454. Although the conflicting claims are not identical, they are not patentably distinct from each other because the distillate fractions and blended-fuels of the instant application are of the same or overlapping boiling range of the distillate fractions and blended fuels of the copending application 08/562,454.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-2, 4 and 15-30 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 08/138,130. Although the conflicting claims are not identical, they are not patentably distinct from each other because the distillate fractions and blended fuel of the instant

Art Unit: 1714

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant's arguments filed August 01, 2000 have been fully considered but they are not persuasive.

Applicants' filing of the proper terminal disclaimers along with the proper fee over U.S. Patents 5,766,274 and 5,689,031 and co-pending application Nos. 09/464,179; 08/544,343; 09/098,231; 09/135,850 and 09/18,130 have been made of record. However, applicants are reminded that a terminal disclaimer may be used to overcome claims that are duplicate claims in co-pending applications and in U.S. Patent applications.

The Examiner acknowledges applicants' hand-delivered receipt of the box containing the accompanying reference for the 21 pages of PTO-1449 delivered by Betty Byrd Inc. As indicated by the Examiner the box containing the said references were not found by the Examiner. If applicant does not intend to supply the Examiner with the requested technical references and articles listed under the other disclosures, then perhaps applicants will notify the Examiner of any of the related co-pending applications and/or U.S. Patents that applicants may have filed the same references (U.S. and foreign) and technical article references and the Examiner will review them and return the initial 21 pages of form PTO-1449

The references applied in the above rejection were made of reference by applicants

Application/Control Number: 08971254

Page 7

Art Unit: 1714

Any inquiry concerning this communication should be directed to Margaret B. Medley at telephone number (703) 308-2518.

MMedley:evh

03-14-01

*Margaret B. Medley*  
**MARGARET MEDLEY**  
**PRIMARY EXAMINER**